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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,425

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Lee A. Chase

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EXAMINER

STORMER, RUSSELL D

ART UNIT

PAPER NUMBER

3617

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/775,425	<b>Applicant(s)</b> CHASE ET AL.	
	<b>Examiner</b> Russell D. Stormer	<b>Art Unit</b> 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the most recently submitted drawings, filed December 26, 2001 and January 16, 2002, appear to be proposed corrections as they are incomplete sets of the drawings and they contain marked-up figures. It appears that Applicants have not submitted formal drawings including the most recent changes made.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the axial protrusion extending “radially outward from the rim portion” as set forth in claim 42 must be shown or the feature(s) canceled from the claim(s).

#### **No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

There is no description of the axial protrusion which extends "radially outward from the rim portion" as set forth in claim 42.

On page 23 of the most recent substitute specification, an axial protrusion 438Z is described as underlying the flange lip, but there is not indication that this axial protrusion extends outward from the rim. The disclosure is therefore non-enabling for this feature.

See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

The disclosure is objected to because of the following informalities: On page 23, in line 8, the phrase "before it blends" should be changed to - -before it would blend- -; and the phrase "that is integral" should be changed to - -that would be integral- - because the sentence which contains these phrases is describing a rim in which the flange lip 138X is not present. Applicants may employ other wording, but it is felt that the current wording in line 8 is confusing and incorrect.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is no support for the axial protrusion extending radially outward from the rim portion, as noted in the objection to the specification above.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 29-41 and 53-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (U.S. Patent No. 5597213; hereafter Chase '213) in view of Eikhoff et al (U.S. Patent No. 6200411; hereafter Eikhoff et al).

Chase '213 discloses a wheel and overlay assembly comprising an overlay adhesively attached to the wheel and having a flange whose outer diameter at the flange lip is clearly less than that of the rim. See figures 5, 6, and 7. This structure would inherently reduce the potential for damage caused by tire-changing equipment.

The overlay may have an offset 120 as shown in figure 3.

As shown in figure 7, the rim has a flange (having planar area 530) terminating in a flange lip 522 defining a radially outermost edge thereof. The flange lip 522 is considered to be truncated inasmuch as it is axially shorter than some of the other flange lips shown in the patent, such as the lip 122 shown in figure 3. The axially facing surface or radial thickness of the flange lip 522 is a portion of the flange lip which extends substantially perpendicular to the axis of the wheel. The peripheral flange lip (unlabelled) of the overlay does not cover this portion of the flange lip.

Eikhoff et al (previously cited; newly applied) teaches a wheel having an overlay which may extend radially outward to the axially extending rim flange lip 76 as shown in figure 9; or may extend beyond the outermost edge 76a so as to cover the entire

perpendicular portion of the flange (the radially thickness of the flange lip) as shown in figure 10; or may cover or overlay only a portion of the perpendicular portion of the flange lip as shown in figure 11.

From this teaching it would have been obvious that the peripheral flange lip of the overlay of Chase '213 could have been modified to overlay the entire perpendicular portion of the flange lip of the rim flange, or just a portion thereof. Therefore, those of ordinary skill in the art would have found it obvious to extend the peripheral flange to overlay only a portion of the perpendicular portion of the flange lip of Chase '213 in order to partially cover that part of the lip or to prevent contact between the tire and the overlay and still hide the wheel rim. Moreover, the modification would yield the predictable result of covering a desired portion of the rim flange.

With respect to claims 34 and 58, note that the overlay may be secured to the wheel by a foam adhesive and a silicon adhesive for sealing the assembly as described in column 9, lines 32-43.

With respect to claims 30, 31, 54, and 55, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance.

Official Notice is hereby given with respect to claims 35-40 and 59-64. It is noted that Applicant has not challenged this taking of Official Notice from the previous office action in the Arguments filed October 12, 2007, and therefore the subject matter of claims 35-40 and 59-64 is taken to be admitted prior art. See MPEP 2144.03.

With respect to claim 41, it is well-known in the art that the peripheral flange portion of an overlay can be shaped or sized to combine with the rim flange lip to accept an industry standard balance weight, and to form the wheel and overlay assembly of Chase '213 as modified by Eikhoff et al to accept such a weight would have been obvious in order to allow the completed wheel assembly to be balanced by standard weights as this would be more desirable than designing different weights for the same purpose.

### ***Allowable Subject Matter***

Claims 42-52 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### ***Response to Arguments***

Applicant's arguments with respect to claims 29-41 and 53-66 have been considered but are moot in view of the new grounds of rejection.

The reference to claim 1 on page 11 of the response filed April 8, 2008 is interpreted as claim 29 inasmuch as claim 1 has been cancelled and claim 29 is referred to elsewhere on the same page.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other teachings of wheel covers which may be modified to change the portion of the wheel rim which is covered by the covers.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Russell D. Stormer/  
Primary Examiner, Art Unit 3617